

REMARKS/ ARGUMENTS

Applicant has carefully studied the final Examiner's Action mailed June 9, 2009, having a shortened statutory period for response set to expire, with a one-month extension, on October 9, 2009. The amendment appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Claims Restriction

The Office found claims 8-10 directed to an independent or distinct invention from the subject matter originally claimed, and withdrew the claims from consideration.¹ The Office noted that claims 8-10 relate to a method of packaging an article, which was previously withdrawn without traverse. As such, claims 8-10 currently stand withdrawn.

Claim Rejection - 35 U.S.C. § 112, paragraph 2

Claims 6-7 and 12-18 stand rejected under 35 U.S.C. §112, paragraph 2 as failing to particularly point out and distinctly claim the subject matter of the invention. In particular, the Office noted that claim 6 recited an outlet port, but that the outlet port lacks antecedent basis in the claim.² Applicant thanks the Office and has corrected the limitation to recite an inlet port. Applicant submits that the amended claim addresses the Office's concerns and respectfully requests the Office withdraw the 35 U.S.C. §112, paragraph 2 rejection of claims 6-7 and 12-18.

Claim Rejection - 35 U.S.C. § 103

Claims 6-7, and 12-18 stand rejected under 35 U.S.C. § 103(a), as being obvious over *Kim* (U.S. Pat. No. 5,624,035) and *Slepian* (U.S. Pat. No. 6,182,826). The Office found *Kim* discloses an inflatable box as claimed in claim 6, having a hollow interior, a first inflatable bladder disposed on the sidewalls, an inlet port, and an outlet port.³ The Office noted *Kim* does not provide a normally closed valve disposed in sealing engagement with an opening in the box, nor a normally closed valve having an inlet port external to the box.⁴ The Office found that *Slepian* compensates for the deficiencies in *Kim* and found it "obvious to have the valve of *Kim* be normally closed and the port being located on the external portion of the container ... [since] such a modification would keep the air inside the bladder so that it will not deflate and can be

¹ Page 2 of the final Office Action, dated June 9, 2009.

² Page 2 of the final Office Action, dated June 9, 2009.

³ Pages 3-4 of the final Office Action, dated June 9, 2009.

⁴ Page 4 of the final Office Action, dated June 9, 2009.

opened to provide an exit path for the air included in the bladder.”⁵ The Office then concluded it would be obvious to combine the references because states the modification would secure an article in the box, preventing damage.⁶ Applicant traverses the finding of obvious as (1) the proposed combination of references does not teach every element of the invention; (2) the claimed invention provides unexpected results, not disclosed by the proposed combination; and (3) a *prima facie* case of obviousness has not been established.

Kim and *Slepian* fail to disclose the claimed invention because the proposed combination of references does not teach every element of the invention. “All limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a process or method claim.”⁷ *Kim* discloses a carrying case with “a plurality of sections **28** and air interconnect conduits **30**. Each section **28** of the enclosure assembly **22** attaches to at least one interconnect conduit **30**. The interconnect conduits **30** connect between adjacent sections **28** to communicate air between each section **28** and an adjacent section **28**.”⁸ Conversely, claim 6 provides “a first inflatable bladder disposed within said hollow interior of said box, wherein said first inflatable bladder is connected to each said sidewall and wherein said first inflatable bladder is disposed in protecting relation to said bottom wall of said box[.]” Claim language is interpreted based on the ordinary and customary meanings of a term, as viewed in light of the specification.⁹ Thus a single inflatable bladder is connected to the sidewalls of the box, and also oriented as to protect the bottom wall. *Kim* fails to disclose an inflatable bladder, but uses a series of inflatable bladders that are connected by a series of conduits. The design of the claimed subject matter allows a user to place an object into the box, seal the box and then inflate the cushioning.¹⁰ The present invention provides for the first inflatable bladder to be attached to the four sidewalls of the package with a portion of the bladder extending to cover the bottom of the package. This permits the cushion to be inflated at

⁵ Page 4 of the final Office Action, dated June 9, 2009.

⁶ Page 4 of the final Office Action, dated June 9, 2009.

⁷ MPEP 2116.01. See also, MPEP 2143.03.

⁸ *Kim* (U.S. Pat. No. 5,624,035), column 3, lines 40-45.

⁹ See, MPEP 2111.01(I) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) (“This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification.”); MPEP 2111.01(III) (citing “*Phillips v. AWH Corp.*,” 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005)) (“[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.”).

¹⁰ Page 2 line 28 to page 3, line 2 of the Application.

the bottom and sides at the same time, thereby providing an efficient cushioning around the article, as seen in figures 4 and 10.

The case designed by *Kim* must be inflated prior to closing the case, as the inflator is located in the interior section of the case. *Kim* limits the protection afforded by the cushions by requiring the user to inflate the cushions prior to case closure. The user must guess the proper inflation, with the case fully open or top still open, since the inflator is located inside the case. Thus, cushions cannot be optimally inflated.

Slepian does not disclose a box, but a conical pad that covers a golf bag. Applicant points out that the claims provide a bladder connected to the sidewalls of the box and oriented as to protect the bottom wall. *Slepian* fails to disclose such a bladder. Thus, the combination of *Kim* and *Slepian* fail to disclose the elements of the claimed invention.

The Office found *Kim* discloses an opening formed in said box.¹¹ Applicant respectfully traverses this finding as claim 6 provides that the box possesses an opening, and that the opening is sealingly engaged with a valve.¹² MPEP 2141.02(I) states that a claim must be considered in its entirety.¹³ Thus, the claim may not be dissected and its parts analyzed in the abstract, but each part must be considered for what is claimed. Here, the claim provides an opening that is sealingly engaged with a valve. As noted by the Office, *Kim* does not disclose a normally closed valve.¹⁴ Applicant therefore submits that *Kim* fails to disclose the opening, as contended by the Office.

The combination of *Kim* and *Slepian* do not obviate the claimed invention as the claimed invention possesses properties not expected in the combined references. The claimed box allows a user to place an object into the box, seal the box and then inflate the cushioning.¹⁵ The present invention provides for the first inflatable bladder to be attached to the four sidewalls of the package with a portion of the bladder extending to cover the bottom of the package. This permits the cushion to be inflated at the bottom and sides at the same time, thereby providing an efficient cushioning around the article, as seen in figures 4 and 10. The *Kim* package is designed

¹¹ Page 4 of the final Office Action, dated June 9, 2009.

¹² See, claim 6 ("an opening formed in said box; a normally closed valve disposed in sealing engagement with said opening").

¹³ Citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983) ("In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.").

¹⁴ Page 4 of the final Office Action, dated June 9, 2009.

¹⁵ Page 2 line 28 to page 3, line 2 of the Application.

such that the series of bladders and connected by conduits limit the flow of air from one bladder to the next. Additionally, the drawings in *Kim* indicate that the bladders are connected in series, meaning that the first bladder must have a certain air pressure before the next bladder begins to fill, and only once the second bladder and first bladder have a sufficient pressure, does air flow into the third bladder. This process does not allow for proper positioning of articles in the *Kim* case, since the partially inflated bladders alter the position of the articles. Additionally, the conduits limit air flow from one bladder to the next. Should an outside force apply pressure to one side of the *Kim* carrying case, the limited air flow results in discrete regions of high pressure, and can cause loss of bladder integrity or damage to the articles. The use of a bladder to protect the sidewalls and bottom of the permit efficient transfer of air throughout the bladder, should the package be struck by an outside force. This provides an enhanced protection, not provided by *Kim*.

Slepian discloses a conical, layered protecting sleeve that fits onto golfing bags. Applicant points out that *Slepian* lacks a box having a hollow interior defined by a top wall, a bottom wall, and sidewalls interconnecting said top and bottom walls, and does not provide for protecting the bottom part of the shipping article, as it relies on the golf bag. The limitations provide a cushion that surrounds the article and fills the interstitial space under the article and on the sides of the article. The modification proposed by the Office would add a valve and external inlet port.¹⁶ This proposed device still suffers from the drawbacks of *Kim*, namely that airflow is restricted through the various bladders. As such, Applicant submits that the claimed invention provides unexpected results, not disclosed in *Kim* and *Slepian*, and thus the claimed invention is not obviated.¹⁷

The combination of *Kim* and *Slepian* fail to obviate the claimed invention as Applicant submits no rational underpinning in support of the obviousness has been propounded and therefore a *prima facie* case of obviousness has not been established. In supporting the finding of obviousness, the Office stated that it would be obvious to use the valve of *Kim* be normally closed and the port located on the exterior of the container as discussed by *Slepian* because “such a modification would keep the air inside the bladder so that it will not deflate and can be opened

¹⁶ See, page 4 of the final Office Action, dated June 9, 2009.

¹⁷ See, MPEP 2143.02(I) (citing *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)) (“The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success.”).

to provide an exit path for the air included in the bladder.”¹⁸ MPEP 2142 states that support for a finding of obviousness requires a clear articulation of the reasons with some rational underpinning to support the finding.¹⁹ The Office’s finding, that it is obvious to include the *Slepian* valve disposed in an opening of a container with the container of *Kim* because the combination would keep air inside the bladder, does not indicate why one would find it obvious to combine a valve disposed in an opening, i.e. the valve allowing external inflation. Applicant submits that the reasoning does not support a determination of obvious, and is tantamount to impermissible hindsight reasoning.²⁰ As such, it is submitted that a *prima facie* case of obviousness has not been established.

In respect to claim 12, Applicant respectfully points out that *Kim* does not disclose a first inflatable bladder disposed in relation to the sidewalls, as found by the Office.²¹ As stated above, *Kim* discloses a plurality of sections 28 and air interconnect conduits 30. Each section 28 of the enclosure assembly 22 attaches to at least one interconnect conduit 30. The interconnect conduits 30 connect between adjacent sections 28 to communicate air between each section 28 and an adjacent section 28.”²² The plurality of bladders is not similar to a single bladder, as provided by the claims.²³ Further, the implications of using a single bladder are very different from a series of bladders, as discussed above.

In respect to claim 14, the Office found *Kim* discloses an inflatable box ... made of a semi rigid material (The cushion 28 is part of the box and is capable of conforming to any shape[.])”²⁴ Applicant respectfully points out that claim 14 states “[t]he package of claim 6, wherein said box is made of a semi-rigid material.” The limitations of claim 6²⁵ provide in pertinent part, “a box having a hollow interior defined by a top wall, a bottom wall, and sidewalls interconnecting said top and bottom walls; [and] a first inflatable bladder disposed within said

¹⁸ Page 4 of the final Office Action, dated June 9, 2009.

¹⁹ “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”

²⁰ See, MPEP 2142 (impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art).

²¹ See, page 5 of the final Office Action, dated June 9, 2009.

²² *Kim* (U.S. Pat. No. 5,624,035), column 3, lines 40-45.

²³ See claim 6 (“a first inflatable bladder disposed within said hollow interior of said box, wherein said first inflatable bladder is connected to each said sidewall and wherein said first inflatable bladder is disposed in protecting relation to said bottom wall of said box;”) (emphasis added).

²⁴ Page 5 of the final Office Action, dated June 9, 2009.

²⁵ See, 35 U.S.C. 112, paragraph 4 (“A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”).

hollow interior of said box, wherein said first inflatable bladder is connected to each said sidewall and wherein said first inflatable bladder is disposed in protecting relation to said bottom wall of said box[.]” As can be seen, the terms box and bladder are listed as separate elements of the claim. “Different claim terms are presumed to have different meanings.”²⁶ It is therefore submitted that the findings presented by the Office are incorrect.

Kim and *Slepian* fail to disclose the claimed invention as the references disclose a carrying case with a plurality of bladders connected via air interconnect conduits or a conical golf bag cap, whereas the claimed invention provides a single bladder covering the sidewalls and bottom. The design of the claimed subject matter permits the cushion to be inflated at the bottom and sides at the same time, thereby providing an efficient cushioning around the article. Further, *Kim* and *Slepian* do not obviate the claimed invention as the present invention provides for the first inflatable bladder to be attached to the four sidewalls of the package with a portion of the bladder extending to cover the bottom of the package. This permits the cushion to be inflated at the bottom and sides at the same time, thereby providing an efficient cushioning around the article, and permits efficient transfer of air throughout the bladder. The device proposed by the Office suffers from the drawbacks of *Kim*, namely that airflow is restricted through the various bladders. Moreover, *Slepian* does not provide cushioning on the bottom of its bag cap, as the bottom uses a typical golf bag. Finally, the combination of *Kim* and *Slepian* fail to obviate the claimed invention as Applicant submits no rational underpinning in support of the obviousness has been propounded. The Office’s finding, that it is obvious to include the *Slepian* valve disposed in an opening of a container with the container of *Kim* because the combination would keep air inside the bladder, does not indicate why one would find it obvious to combine a valve disposed in an opening, i.e. the valve allowing external inflation. Applicant submits that the reasoning does not support a determination of obvious, and is tantamount to impermissible hindsight reasoning. Accordingly, Applicant respectfully requests the Office withdraw the 35 U.S.C. § 103 rejection of claims 6-7, and 12-18.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Office is not fully persuaded as to the merits of Applicant’s position, or if an Examiner’s

²⁶ *Univ. Texas v. Benq America Corp.*, 553 F.3d 1362, 1371, 87 U.S.P.Q.2d 1437 (Fed. Cir. 2008) (citing *Cae Screenplates Inc. v. Heinrich Fiedler GmbH & Co.*, 224 F.3d 1308, 1317, 55 U.S.P.Q.2d 1804 (“the use of these

Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (813) 925-8505 is requested.

Very respectfully,

SMITH & HOPEN

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CERTIFICATE OF ELECTRONIC TRANSMISSION

(37 C.F.R. 2.190 (b))

I HEREBY CERTIFY that this correspondence is being electronically transmitted to the Patent and Trademark Office through EFS Web on October 5, 2009.

Date: October 5, 2009

/jessica thompson/
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different terms in the claims connotes different meanings.”).